REMARKS

In item 1 on page 2 of the Office Action mailed February 10, 2004, the Examiner acknowledged the previous cancellation of claim 3 and amendments to claims 1, 2, 8-11, 13-16, 19, 22, and 23.

In item 2, on page 2 of the Office Action, the Examiner proposed a particular interpretation for a phrase in the specification. The Examiner asked whether Applicants agreed with that interpretation.

The Examiner acknowledged the previous withdrawal of claim 27 in item 3, page 3 of the Action.

The Examiner withdrew several previous objections to the specification, and the Examiner also withdrew previous rejections of certain claims. These matters are described in item 4 on pages 3-4 of the Office Action.

In item 5, on pages 4-8 of the Office Action, the Examiner objected to the disclosure of the application. Specifically, the Examiner presented a listing of (1) to (4) for which clarification was requested.

In item 6, on pages 8-9 of the Office Action, the Examiner objected to the disclosure and presented (1) and (2) in support of this objection.

In item 7, on pages 9-11 of the Office Action, the Examiner objected to the specification for allegedly failing to provide proper antecedent basis for the claimed subject matter.

In items 8-9 of the Office Action, on pages 11-13, the Examiner alleged that claim 11 is indefinite under 35 U.S.C. § 112, second paragraph.

In items 10-11, on pages 13-17 of the Office Action, the Examiner rejected claims 1 and 4-26 under 35 U.S.C. § 112, first paragraph, for purportedly containing subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors at the time the application was filed, had possession of the claimed invention.

On pages 17-18, in item 12, the Examiner objected to claim 14.

In item 15, on pages 18-23 of the Office Action, the Examiner rejected claims 1, 2, 7-9, 22-24, and 26 under 35 U.S.C. § 103(a) as unpatentable over Hendrickson combined with Knauf, Grant & Hackh, Borsenberger et al., and Ong.

In item 16, on pages 23-24, claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hendrickson combined with Knauf, Grant & Hackh, Borsenberger et al., and Ong, and further combined with Horgan.

In item 18, on pages 25-29, the Examiner rejected claims 1, 2, 6-9, 11-16, 20-24, and 26 under 35 U.S.C. § 103(a) as unpatentable over Ong combined with Borsenberger et al., Brown, Hendrickson, Knauf, and Grant & Hackh.

In item 19 on pages 29-31, claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ong combined with Borsenberger et al., Brown, Hendrickson, Knauf, Grant & Hackh, and further combined with Horgan.

In item 20, on pages 31-34 of the Office Action, the Examiner rejected claims 1, 2, 6-9, 12-16, 20-24, and 26 under 35 U.S.C. § 103(a) as unpatentable over Ong combined with Borsenberger et al., Brown, Hendrickson, Knauf, and Grant & Hackh.

In item 21, on pages 34-35 of the Office Action, the Examiner rejected claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over Ong combined with Borsenberger et al., Brown, Hendrickson, Knauf, Grant & Hackh, and further combined with Horgan.

In item 22, appearing on pages 35-38 of the Office Action, claims 1, 2, 6-9, 12-18, 20-24, and 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over Pai combined with Borsenberger et al., Brown, Hendrickson, Knauf, and Grant & Hackh.

In item 23, on pages 38-40 of the Office Action, claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as unpatentable over Pai combined with Borsenberger et al., Brown, Hendrickson, Knauf, Grant & Hackh, and further combined with Horgan.

In item 24, on pages 40-41 of the Office Action, claim 19 was rejected under 35 U.S.C. § 103(a) as unpatentable over Pai combined with Borsenberger et al., Brown, Hendrickson, Knauf, and Grant & Hackh, and further combined with Yanus.

In item 26, on pages 42-46 of the Office Action, claims 1, 2, 7-9, 13, 15, 16, and 22-26 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Nguyen combined with Hendrickson, Knauf, Grant & Hackh, Springett, and Borsenberger et al.

In item 27, on pages 46-51, claims 1, 2, 4-9, 13-16, and 21-26 were rejected under 35 U.S.C. § 103(a) as unpatentable over Chu combined with Nguyen, Hendrickson, Knauf, and Grant & Hackh.

Claims 1, 2, 4-26, and 28-29 are pending and are believed to be in a condition for allowance.

A. Previous Acknowledgment of Cancellation of Claim 3 and Amendments to Claims 1, 2, 8-11, 13-16, 19, 22, and 23

In item 1 on page 2 of the Office Action mailed February 10, 2004, the Examiner acknowledged the previous cancellation of claim 3 and amendments to claims 1, 2, 8-11, 13-16, 19, 22, and 23. The Examiner also stated that claims "1, 2, and 4-27 are pending."

B. Examiner's Interpretation of Description in Specification

In item 2, on page 2 of the Office Action, the Examiner proposed a particular interpretation for a phrase in the specification. The Examiner asked whether Applicants agreed with that interpretation.

Specifically, the Examiner asserted:

> The examiner interprets the phrase "the aryl amine contains X, having from about 1 to about 12 carbon atoms" (emphasis added) in the amended paragraph beginning at page 6, line 4, of the specification, filed in Paper No. 6, to mean that the aryl amine of the formula disclosed in that paragraph comprises the group X, which is defined as an alkyl having about 1 to about 12 carbon atoms. Support for the examiner's interpretation is found at page 10, lines 4-5, of the specification, which discloses that "the aryl amine alkyl contains from about 1 to about 12 carbon atoms," where the alkyl is the substituent group X in the formula disclosed in that paragraph.

Page 2 of the Office Action.

Applicants agree with the Examiner's interpretation.

C. Previous Withdrawal of Claim 27

The Examiner acknowledged the previous withdrawal of claim 27 in item 3, page 3 of the Action.

Since claim 27 was previously withdrawn, Applicants hereby cancel that claim without prejudice, and reserve their right to prosecute that claim in one or more subsequent applications.

D. Withdrawal of Previous Objections and Rejections

The Examiner withdrew several previous objections to the specification, and the Examiner also withdrew previous rejections of certain claims. These matters are described in item 4 on pages 3-4 of the Office Action.

Applicants acknowledge the withdrawal of those previous objections and rejections.

E. Objections to Disclosure of Application Must Be Withdrawn

In item 5, on pages 4-8 of the Office Action, the Examiner objected to the disclosure of the application. Specifically, the Examiner presented a listing of (1) to (4) for which clarification was requested.

Specifically, the Examiner asserted:

> (1) The specification at page 5, lines 8-10, discloses "a hole blocking layer wherein" (emphasis added) the reference labels "a" through "d" have particular numerical values. It is not clear what is meant by the passage. It is not clear whether the indefinite article in the phrase "a hole blocking layer" (emphasis added) refers to the previously described hole blocking layer comprising the crosslinked polymer of formula (III) or to another hole blocking layer comprising another embodiment of the polymer of formula (III). Clarification is requested.

Pages 4-5 of the Office Action.

The Examiner is requested to consider the passage beginning on page 3, line 21 of the application. There, it is noted that in one aspect, the present invention relates to an imaging member comprising a particular combination of components including a hole blocking layer. The hole blocking layer, in this aspect, comprises a particular silane having a formula defined in part by the letters a-d. Those letters denote mole fractions of the polymer structure (III) on page 4 of the application. That description notes that "a, b, c, and d are mole fractions of the repeating monomer units wherein a+b+c+d is equal to about 1." See page 5, lines 1-2 of the application.

The description continues and notes another aspect related to the present invention, "a photoconductive imaging member where a is from about 0 to about 0.95, b is from about 0.001 to about 0.50, c is from about 0 to about 0.50, and d is from about 0.01 to about 0.95." See page 5, lines 7-10. The mole fractions a, b, c, and d are mole fractions of the polymer structure (III) on page 4 of the application.

The Examiner will appreciate that the disclosure describes various aspects of a silane polymer used in a hole blocking layer of an imaging device. It is believed that upon further review, the Examiner will understand the present disclosure and withdraw this ground of objection.

The Examiner also asserted another objection as follows:

> (2) The specification at page 5, lines 10-17, discloses "a hole blocking layer wherein" (emphasis added) A, B, D, and F may present particular organic groups. It is not clear what is meant by the passage. It is not clear whether the indefinite article in the phrase "a hole blocking layer" (emphasis added) refers to the previously recited hole blocking layer comprising the crosslinked polymer of formula (III) or to another hole blocking layer comprising another embodiment of the polymer of formula (III). Clarification is requested.

Page 5 of the Office Action.

The passage cited by the Examiner refers to another aspect related to the present invention. This aspect concerns a photoconductive imaging member wherein A is selected from a particular group of divalent linkages, and further wherein B, D, and F are each independently selected from the group set forth at page 5, lines 14-15 of the application. The groups A, B, D, and F are segments of the polymer backbone of structure (III) on page 4 of the application. It is submitted that upon further review, the Examiner will understand the present disclosure and withdraw this ground of objection.

The Examiner also asserted another objection as follows:

> (3) The specification at page 6, line 15, discloses the charge transport polymer polysebacoyl-TBD (PSEB). It is not clear what is the polymer polysebacoyl-TBD, which the specification neither defines nor describes.

Page 5 of the Office Action.

Polysebacoyl is a hole transporting polymeric material of N,N'-diphenyl-N,N'-bis[3-hydroxyphenol]-[1,1 biphenyl] -4,4'diamine and sebacoyl chloride known in the art such as in Example VIII of U.S. Patent 5,606,396; Example 8 of U.S. Patent 6,165,670; and U.S. Patent 5,262,512 for example. Thus, this charge transport polymer is understood by those skilled in the art.

The Examiner also contended:

> (4) In the only example in the specification, the hole blocking layer is said to comprise a polymer of Formula (III). See the specification, page 18, line 26, to page 19, line 1. The specification at page 3, line 26, to page 4, line 5, discloses that the polymer represented by Formula III is obtained by reacting a polymer of Formula I with an organosilane of Formula II. However, in the example, the hole blocking layer is obtained from a solution comprising 3-aminopropyltrimethoxy-silane. There is no

> disclosure of reacting the silane compound with a polymer of Formula I. Thus, it is not clear how the blocking layer in the example comprises a polymer of Formula III.
>
> It is noted that the example is not within the scope of the presently claimed invention because it does not comprise a cross-linked silicone rubber and a resilient, electrically insulating overcoating layer, as required in instant claims 1 and 2.

Page 5-6 of the Office Action.

An important distinction must be recognized. The specification describes several embodiments of the hole blocking layer. One of these embodiments relates to the hole blocking layer comprising a crosslinked polymer, a hydrolyzed silane, derived from the reaction of polymer (I) and an organosilane represented by (II). See page 3, lines 25-27. The specification continues and notes that the hole blocking polymer "can be schematically represented by (III), which is derived from the crosslinking reaction as described in Scheme 1." See page 3, line 28 to page 4, line 2. There is no requirement in the broader claims of the application that the hole blocking layer polymer be produced from the reaction of Scheme 1.

This is further confirmed by additional disclosure in the specification in which alternate embodiments of the hole blocking layer are disclosed:

> wherein the hole blocking layer contains a crosslinked polysiloxane polymer network impregnated with a hydroxyl-functionalized polymer and photogenerating pigments;

See page 8, lines 23-25. Yet another embodiment of the hole blocking layer is disclosed as:

> wherein the hole blocking layer contains a hydroxyl-functionalized polymer intertwined in a crosslinked polysiloxane network generated from crosslinking an organosilane reagent represented by Formula (I) or (II) below,

Page 8, lines 25-28. And still, further embodiments are described as:

> The hole blocking layer may include polymers such as polyvinylbutyral, epoxy resins, polyesters, polysiloxanes, polyamides, polyurethanes and the like, or may be nitrogen containing siloxanes or nitrogen containing titanium compounds such as trimethoxysilyl propylene diamine, hydrolyzed trimethoxysilyl propyl ethylene diamine, N-beta-(aminoethyl) gamma-amino-propyl trimethyoxy silane, isopropyl 4-aminobenzene sulfonyl, di(dodecylbenzene sulfonyl) titanate, isopropyl di(4-aminobenzoyl)isostearoyl titanate, isopropyl tri(N-ethylamino-ethylamino)titanate, isopropyl trianthranil titanate, isopropyl tri(N,N-dimethyl-ethylamino)titanate, titanium-4-amino benzene sulfonate oxyacetate, titanium 4-aminobenzoate isostearate oxyacetate, $[H_2N(CH_2)_3]CH_3Si(OCH_3)_2$, (gamma-aminobutyl)methyl diethoxysilane, and $[H_2N(CH_2)_3]CH_3Si(OCH_3)_2$ ((gamma-aminopropyl)methyl diethoxysilane, as disclosed in U.S. Patent Nos. 4,338,387, 4,286,033 and 4,291,110. The disclosure of each of these patents is totally

> incorporated herein by reference. A specific hole blocking layer is generated from the reaction product of a hydrolyzed silane or mixture of hydrolyzed silanes and the oxidized surface of a metal ground plane layer.

Page 12, lines 6-22.

So, the Examiner will appreciate that a wide array of polymers and materials may be utilized in the hole blocking layer of the imaging members recited in the pending claims. There is no requirement that the 3-aminopropyl trimethoxysilane of the example (see page 18, line 27) be formed according to the reaction scheme 1 exemplified on page 4 of the application.

The Examiner also asserted that the example is not within the scope of the presently claimed invention because it does not comprise a crosslinked silicone rubber and an overcoating layer as recited in claims 1 and 2.

The Examiner is directed to page 6, lines 20-24 and page 18, lines 10-20 of the present application. There, it is disclosed that in certain embodiments, the imaging device may include an insulative layer of a crosslinked silicone rubber, and a resilient electrically insulating overcoating layer. One skilled in this field of art would readily appreciate that after producing the imaging device described in the example on pages 18-19 of the application, an insulating layer of silicone rubber and a resilient, electrically insulating overcoating layer could be deposited thereon, as disclosed on page 18, immediately preceding the example.

In view of the foregoing, the Examiner will agree that the various objections must be withdrawn.

F. Additional Objections to Disclosure of Application Must Be Withdrawn

In item 6, on pages 8-9 of the Office Action, the Examiner objected to the disclosure and presented (1) and (2) in support of this objection.

> (1) The specification at page 7, lines 23-27, discloses that "positive charges are placed at the injecting contact; these charges are injected into the transport layer . . .as shown in Fig. 2." However, the imaging member shown in Fig. 2 comprises a hole blocking layer 3 between the charge injecting surface 2 and the charge transport layer 5. The blocking layer 3 would not permit charges to be injected from the charge injecting surface 2 to the charge transport layer 5. Therefore, it is not clear how charges are injected from the injection surface 2 to the charge transport layer 5 as disclosed in the instant specification.

The passage in the present disclosure that is in question, is as follows:

> Figure 1 is a cross-sectional view of a multilayered imaging member containing a substrate 1, a charge injecting surface 2, a hole blocking layer 3, an optional adhesive layer 4, a charge transport layer 5, a charge generating layer 6, an optional trapping layer 7, a cross-linked silicone rubber layer 8 and an overcoating layer 9. An insulating and transparent resinous binder 10 is dispersed throughout the charge transport layer and the charge generating layer.
>
> Charge negatively, wherein a corotron places negative charges on top of the overcoating layer 9 and the positive charges are placed at the injecting contact; **these charges** are injected into the transport layer and travel to the interface between the generator layer 6 and the overcoat layer 9, as shown in Fig. 2.
>
> Charge positively, where positive charges placed on the top surface of the charge generating layer 6, neutralize the negative charges. The negative charges placed at the injecting contact remain in place.

Pages 7-8 of the application (emphasis added).

The bolded reference to "these charges" in the disclosure of the imaging member being charged negatively, refers to both negative charges and positive charges. The Examiner is correct in noting that the hole blocking layer can block the migration of a positive charge. However, the passage set forth above merely describes that the charges pass into the transport layer and travel to the noted interface. It is believed that at least a majority of these charges are negative, hence the reference to "charge negatively."

This understanding is further confirmed by the next aspect described in the passage set forth above. After the member has been negatively charged, it is then positively charged.

It is believed that upon further review, the Examiner will understand the cited passage and withdraw this ground of objection.

In item (2) of the objections, the Examiner contended:

> (2) The paragraph beginning at page 8, line 14, of the specification, filed in Paper No. 6, was amended to disclose that the cross-linked silicone contains cross linking of "about 6% to about 9%" (emphasis added). It is not clear what is the basis of the cross linking (e.g., mole, weight, number, etc.).
>
> Appropriate correction is required.

Page 9 of the Office Action.

The passage at issue refers to the extent or degree of cross linking when expressed as a percentage, i.e. from 0% to 100%. This is dimensionless.

In view of the foregoing, it is urged that these objections to the disclosure be withdrawn.

G. Objection to Specification Must Be Withdrawn

In item 7, on pages 9-11 of the Office Action, the Examiner objected to the specification for allegedly failing to provide proper antecedent basis for the claimed subject matter. The Examiner cites 37 C.F.R. § 1.75(d)(1) which provides that terms in the claims "must find clear support in the description so that the meaning of the terms...may be ascertainable by reference to the description."

As a first ground of objection, the Examiner asserted:

> (1) In claims 1 and 2, the recitation "a resilient, electrically insulating overcoating layer" lacks antecedent basis in the specification. See page 3, lines 18-20, of the specification, which discloses a "resilient, electrically insulating overcoating layer comprising an elastomer." The layer recited in instant claims 1 and 2 is broader than the disclosed overcoating layer because it includes overcoating layers that do not comprise an elastomer.

Page 9 of the Office Action.

Upon further review, the Examiner will agree that the specification does in fact provide sufficient support for the claimed aspect. On page 18, lines 16-20 of the application, it is noted that the overcoating layer may contain organic polymers or inorganic polymers that are electrically insulating. That is, it is not a requirement that the insulating overcoating layer comprise an elastomer. The use of an elastomer in that layer is one of several preferred embodiments. The term "a resilient, electrically insulating overcoating layer" finds clear support in the application such that its meaning is ascertainable by those skilled in the art.

Next, the Examiner argued:

> (2) In claim 17, the recitation "a charge transporting polymer" lacks antecedent basis in the specification. See page 6, lines 14-15, of the specification, which discloses a charge transporting polymer comprising polyethercarbonate (PEC) or polysebacoyl-TBD (PSEB). The term "a charge transporting polymer" recited in instant claim 17 is broader than the disclosed charge transporting polymer because it includes other charge transporting polymers that are not PEC or PSEB.

Page 10 of the Office Action.

The specification discloses "a charge transporting polymer." The polymers PEC and PSEB are merely preferred embodiments of these polymers. The Examiner appears to be urging that the specification must specifically disclose every polymer

which is encompassed by the recitation of claim 17 for "a charge transporting polymer." The Examiner fails to cite any legal authority for this novel requirement. The term "a charge transporting polymer" finds clear support in the application such that its meaning is ascertainable by those skilled in the art. Applicants submit that upon further review, that the Examiner will agree that this ground of objection should be withdrawn.

In response to previous explanations submitted by Applicants concerning this matter, the Examiner stated:

> Applicants are reminded that to overcome the above objections, they merely have to incorporate the objected limitations recited in the originally filed claims in appropriate locations in the specification.

Page 11 of the Office Action.

In order to avoid any issue over these matters, Applicants herein present amendments to the specification which, as the Examiner stated, will overcome the Examiner's objections.

H. Rejection of Claim 11 Under § 112, Second Paragraph, Must Be Withdrawn

In items 8-9 of the Office Action, on pages 11-13, the Examiner alleged that claim 11 is indefinite under 35 U.S.C. § 112, second paragraph. Specifically, the Examiner raised assertions (1) – (4) as follows.

> (1) The phrase "Z is selected from the group consisting of chloride . . . acyloxy of, for example, from about 2 to about 6 carbon atoms, aryloxy of, for example, from about 6 to about 10 carbon atoms" is indefinite for improper Markush language. Proper Markush language is "R is selected from the group consisting of . . . and . . ." or "R is . . . or . . ." MPEP 2173.05(h) (8th ed., Rev. 1, Feb. 2003). The phrase is missing the conjunction "and". It is not clear whether the group is closed or whether applicants intend the recited Markush group to contain additional components. Thus, it is not clear what is the scope of the instant claim. The "for example" language is regarded as surplusage that does not limit the claim.

Pages 11-12 of the Office Action.

Claim 11 has been clarified to remedy the Examiner's concerns.

Next, the Examiner asserted:

> (2) The phrase "a hole blocking layer, wherein a is from about 0 . . . d is from about 0.01 to about 0.95" (emphasis added) is indefinite for lack of unambiguous antecedent basis. It is not clear whether the indefinite article in the phrase "a hole blocking layer" (emphasis added) refers to the previously recited hole blocking layer comprising the crosslinked polymer of formula (III) or to another hole blocking layer comprising another embodiment of the polymer of formula (III). Clarification is requested.

Page 12 of the Office Action.

Claim 11 has been clarified to remedy the Examiner's concerns. New claim 28 is presented that recites the aspects cancelled from claim 11 pursuant to this clarification.

The Examiner also asserted:

> (3) The phrase "a photoconductive imaging member, wherein A is selected from the group of . . . B, D, and F are independently . . ." (emphasis added) is indefinite for lack of unambiguous antecedent basis. Claim 1 does not recite a photoconductive imaging member. Rather, claim 1 merely recites "an imaging member." Moreover, it is not clear how a photoconductive imaging member is described by the terms "A, B, D, and F" because claim 11 previously recites that those terms represent the segments of the polymer backbone of the polymers of formula I and III, and there is no necessary requirement that the "photoconducting imaging member" contains said polymer of formula III.

Pages 12-13 of the Office Action.

Claim 11 has been clarified to remedy the Examiner's concerns. New claim 29 is presented that recites the aspects cancelled from claim 11 pursuant to this clarification.

The Examiner also asserted:

> (4) The phrase "B, D and F are independently selected from the group consisting of . . . wherein F' . . ." The phrase is missing the conjunction "and' between the second and third chemical structures. It is not clear whether the group is closed or whether applicants intend the recited Markush group to contain additional components. Thus, it is not clear what is the scope of the instant claim.

Page 13 of the Office Action.

The cancellation of the disputed claim language in claim 11 renders this assertion moot. Appropriate language is utilized in new claim 29. Accordingly, it is believed that the Examiner's concern has been remedied.

In view of the foregoing, the rejection under § 112, second paragraph must be withdrawn.

I. Rejection of Claims 1 and 4-26 Under § 112, First Paragraph Must Be Withdrawn

In items 10-11, on pages 13-17 of the Office Action, the Examiner rejected claims 1 and 4-26 under 35 U.S.C. § 112, first paragraph, for purportedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors at the time the application was filed, had possession of the claimed invention.

Specifically, the Examiner argued:

> (1) Instant claims 1 and 10 recite the presence of a hole blocking layer and an optional "charge blocking layer."
>
> The originally filed specification does not provide an adequate written description of an imaging member comprising a hole blocking layer and an optional charge blocking layer, as recited in the instant claims. The originally filed specification at page 3, lines 21 and 23, discloses that the imaging member may comprise an optional hole blocking layer and an optional charge trapping layer. Originally filed claim 1 recites an imaging member comprising an optional hole blocking layer and an optional charge trapping layer. Originally filed Fig. 1 shows an embodiment of the instant claims, an imaging member comprising a substrate having thereon in order a hole blocking layer 3, an adhesive layer 4, a charge transport layer 5, a charge generation layer 6, a trapping layer 7, a cross-linked silicone rubber layer 8, and an overcoating layer 9. Thus, on the present record, the originally claimed optional charge trapping layer is not the same as the optional charge (or hole) blocking layer recited in the instant claims. There is no disclosure in the originally filed specification stating that the originally claimed optional charge trapping layer is the same as the optional charge (or hole) blocking layer recited in the instant claims. Moreover, there is no disclosure in the originally filed specification of an imaging member comprising two hole blocking layers. (The specification at page 12, lines 3-6, disclose that a "hole blocking layer [is] capable of forming a barrier to prevent hole injection from the conductive layer to the opposite photoconductive layer." US 5,916,720 (Springett) at col. 3, lines 11-14, identifies a "hole" as a "positive charge." The specification at page 17, lines 7-8, and 29-30, discloses that the charge blocking layer may be interposed between the conductive layer and the photogenerating layer. The specification at page 18, lines 6-7, disclose that "[a] purpose of this layer [the charge blocking layer] is to prevent charge injection from the substrate during and after charging." Thus, based on the evidence on the present record, a hole blocking layer is a charge blocking layer. US 4,291,110 (Lee), which is listed on the form PTO-1449 in Paper No. 2 filed on Dec. 14, 2001, discloses at col. 2, lines 15-18, that a hole (or charge) trapping layer "prevents charges from migrating from the interface between the [charge] generating layer and the overcoating insulating layer to the injecting electrode." According to Lee, a charge injection layer appears to have a different function from that of the hole or charge blocking layer described in the instant specification.)

Pages 14-15 of the Office Action.

Clarifications are hereby presented to claims 1 and 10 which remedy the Examiner's concerns. Specifically, in each of these claims the recitation of "charge blocking" was changed to "charge trapping."

The Examiner also contended:

> (2) Instant claim 15 recites that the charge transport layer of claim 1 "includes at least one substituent, X, with from about 1 to about 12 carbon atoms."
>
> Instant claim 16 recites that the charge transport layer of claim 1 "includes at least one substituent, X, with from about 1 to about 5 carbon atoms." Applicants assert that support for said layers is found in the specification at page 10, lines 5-6, of the specification.

> The originally filed specification does not provide an adequate written description of said charge transport layers. The originally filed specification at page 10, lines 5-6, discloses that the charge transport layer may comprise an aryl amine of the formula disclosed at page 10, line 1, where the substitute group X in the formula may be an alkyl group containing from about 1 to about 12 carbons or from about 1 to about 5 carbon atoms. The originally filed specification does not disclose that the charge transport layer comprises "at least one substituent X" as broadly recited in the instant claims. The recitation is not limited to the particular aryl amine of the formula disclosed at page 6, line 1, of the specification, but includes other components, such as solvents comprising from 1 to 12 or 5 carbon atoms.

Page 16 of the Office Action.

Clarifications are hereby presented to claims 15 and 16 that remedy the Examiner's concerns. Specifically, their former dependency from claim 1 has been changed to claim 14. Applicants direct the Examiner's attention to page 6, lines 4-13 of the present application. There, the subject matter at issue is expressly described.

The Examiner further asserted:

> (3) Instant claim 19 recites "a resinous binder comprising polysebacoyl" (emphasis added). Applicants assert that the specification provides support for said binder at page 6, lines 4-15, of the specification.
>
> The originally filed specification does not provide an adequate written description of said binder comprising polysebacoyl. The originally filed specification at page 6, lines 4-15, discloses that a "charge transporting polymer comprises . . . polysebacoyl-TBD (PSEB)." The specification at page 10, lines 8-9, discloses that the charge transport layer may comprise a "resinous binder selected from the group consisting of polycarbonates and polystyrenes." The specification at page 15, lines 4-7, discloses that the polymer binder material for the charge transport layer may include "polycarbonates, acrylate polymers, vinyl polymers, cellulose polymers, polyesters, polysiloxanes, polyamides, polyurethanes and epoxies as well as block, random or alternating copolymers thereof." The originally filed specification does not disclose that the charge transport layer comprises the broad "resinous binder comprising polysebacoyl" as recited in instant claim 19. The "resinous binder comprising polysebacoyl" recited in instant claim 19 is broader than the disclosed polysebacoyl-TBD because it includes a binder resin not comprising polysebacoyl-TBD.

Pages 16-17 of the Office Action.

The Examiner is not applying the correct standard under § 112, first paragraph. The Court of Appeals for the Federal Circuit stated in this regard:

> It is not required that the application describe the claim limitations in greater detail than the invention warrants. The description must be sufficiently clear that persons of skill in the art will recognize that the applicant made the invention having those limitations.

Martin v. Mayer, 823 F.2d 500, 3 USPQ2d 1333 (Fed. Cir. 1987). The present description is sufficiently clear.

In view of the foregoing, the rejection of claims 1 and 4-26 must be withdrawn.

J. Objection to Claim 14 Must Be Withdrawn

In this regard, the Examiner contended:

> The recitation of the conjunction "and" in the phrase "layer and contains aryl amines" (emphasis added) should be deleted. Appropriate correction is required.

Page 18 of the Office Action.

Clarifications have been presented to claim 14. Accordingly, this ground of rejection must be withdrawn.

K. Rejection of Claims 1, 2, 7-9, 22-24 and 26 Under § 103(a) Must Be Withdrawn

In item 15, on pages 18-23 of the Office Action, the Examiner rejected claims 1, 2, 7-9, 22-24, and 26 under 35 U.S.C. § 103(a) as unpatentable over Hendrickson combined with Knauf, Grant & Hackh, Borsenberger et al., and Ong.

Of the rejected claims, claims 1 and 2 are independent claims. The remaining claims, claims 7-9, 22-24, and 26 are dependent or ultimately dependent from claim 1. Claim 1 recites an imaging member comprising a particular supporting substrate, a hole blocking layer, a charge transport layer, a charge-generating layer, a cross-linked silicone rubber, and a resilient, electrically insulating overcoating layer. Claim 1 further recites the supporting substrate as including a charge-injecting surface. And, claim 1 recites an optional adhesive layer and a charge trapping layer. Independent claim 2 parallels claim 1 but for the recitation of the optional layers.

The Hendrickson patent cited by the Examiner is not particularly relevant to the claims at issue. However, the Examiner asserted in this regard:

> Hendrickson discloses a photoconductive imaging member that meets the compositional limitations recited in the instant claims, but for the presence of a hole blocking layer. Hendrickson's imaging member comprises a conductive substrate, such as an aluminized polyester substrate, a photoconductive layer, and a topcoat comprising a cured film-forming silicone polymer. Col. 2, lines 45-48; col. 3, lines 36-58; and example 3 at cols. 10-11. The photoconductive layer may have a bilayer structure comprising a charge generating layer and a charge transporting layer. Col. 2, lines 62-67. The crosslinked silicone polymer

> is obtained by curing (i.e., crosslinking) the material marked or associated with the trademark SYL-OFF 23, which is identified as a silanol terminated polydimethylsiloxane within the scope of formula II disclosed at col. 3, lines 40-59. See col. 10, lines 19-20. SYL-OFF 23 is also identified as a curable "silicone rubber" polymer. See Knauf, col. 3, lines 54-56. Hendrickson discloses that its imaging member provides 100% toner image transfer with a resolution in excess of 100 line pairs/mm. Col. 2, lines 16-18, and example 3.

Pages 18-19 of the Office Action.[1]

The Examiner failed to identify any teaching or description by Hendrickson as to (i) a hole blocking layer, (ii) the combination of a hole blocking layer and one or more of the layers or components recited in the independent claims, and (iii) the specific combination of a particular substrate, a hole blocking layer, a charge transport layer, a charge-generating layer, a crosslinked silicone rubber, and a resilient electrically insulating overcoating layer. The independent claims each recite (i), (ii) and (iii). Hendrickson does not provide any teachings or suggestions as to these aspects.

Apparently, the Examiner concedes that Hendrickson entirely fails to teach a hole blocking layer. However, the Examiner jumps to a passage by Borsenberger in an attempt to remedy the deficiency of Hendrickson:

> As discussed supra, Hendrickson does not disclose that its imaging member comprises a hole blocking layer as recited in the instant claims. However, as discussed supra, the use of a blocking layer interposed between the conductive substrate and the photoconductive layer (e.g., the charge transport layer and the charge generation layer) to prevent charge injection is well-known in the art. See Borsenberger, paragraph bridging pages 290 and 291, and Fig. 1.

Pages 21-22 of the Office Action.

The cited Borsenberger passage merely refers to a "thin blocking layer." Borsenberger lists various insulating polymers for this layer such as "acrylic polymers, epoxy resins, polyamides, polyesters, polyphosphazenes, polysiloxanes, polyurethanes, vinyl polymers, etc."

Hendrickson and Borsenberger taken together, still fail to teach or describe the combinations (ii) and (iii) recited in the claims at issue. Moreover, it is debatable as to whether Borsenberger provides the requisite teaching for a "hole blocking layer" as recited in the independent claims by a mere reference to a "blocking layer" in a

[1] The Examiner cited Knauf merely for identification of SYL-OFF 23 as a curable rubber polymer. The Examiner cited Grant & Hackh for a definition of "hydrolysis."

background description of a xerographic belt. The Examiner is reminded that rejections under § 103 require specific and unambiguous teachings in the prior art:

> VSI argues that it would have been obvious to one of ordinary skill in the art to punch a hole in the Seaver security tag and hang it from a cantilevered support. VSI points to the problems in the art and the Rosen, German, and Pacelli patents to support this conclusion. VSI is unable, however, to point to any specific teaching or suggestion for making this combination. VSI instead relies on what it presumes is the level of knowledge of one of ordinary skill in the art at the time of the invention to supply the missing suggestion to combine. In the first place, the level of skill in the art is a prism or lens through which a judge or jury views the prior art and the claimed invention. This reference point prevents these deciders from using their own insight or, worse yet, hindsight, to gauge obviousness. Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment. See *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q (BNA) 303, 312-13 (Fed. cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."). Skill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case, but instead supplies the primary guarantee of objectivity in the process. See *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 U.S.P.Q.2D (BNA) 1053, 1057 (Fed. Cir. 1991).

Al-Site Corp. and Magnivision, Inc. v. VSI Int'l, Inc. and Myron Orlinsky; 174 F.3d 1308, 1324 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Notwithstanding this, in order to expedite allowance of the claims, clarifications have been incorporated in independent claims 1 and 2 that further distinguish all claims at issue from the cited art. These claims now recite that the hole blocking layer comprises a hydrolyzed silane. Neither of the documents to Hendrickson nor Borsenberger et al., taken singularly or in combination, teach, describe, or even suggest this aspect. Furthermore, neither Hendrickson nor Borsenberger provide any teaching as to the specific combination of such a hole blocking layer, i.e. one comprising a hydrolyzed silane, in conjunction with the other aspects recited in each of independent claims 1 and 2.

Next, the Examiner cites Ong '877 to apparently remedy the shortcomings of Hendrickson and Borsenberger. The Examiner asserts in this regard:

> It would have been obvious for a person having ordinary skill in the art, in view of the teachings of Borsenberger and Ong '877, to incorporate Ong '877's hole blocking layer between the conductive substrate and the photoconductive layer in the imaging member of Hendrickson, because that person would have had a reasonable expectation of successfully obtaining an electrophotographic imaging member having the benefits disclosed by Ong '877.

Pages 22-23 of the Office Action.

However, Ong fails to teach or even suggest an imaging member that includes a cross-linked silicone rubber as recited in each of the independent claims at issue. Moreover, Ong fails to teach or even suggest an imaging member that utilizes a resilient, electrically insulating overcoating layer as recited in each of the independent claims. Furthermore, Ong entirely fails to teach the combination of these components in an imaging member, or their use in conjunction with the other aspects recited in each of the independent claims.

The Examiner's rejection, essentially based upon the art to Hendrickson, Borsenberger, and Ong; is a classic example of hindsight reconstruction using the present claims as a template to recreate the claimed subject matter. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps." *In re Gorman,* 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

The Examiner has failed to identify any teaching from the collection of cited art for selectively combining the Hendrickson, Borsenberger and Ong art, in the manner that the Examiner has done. It is indisputable that such teaching must come from the art itself. "We do not 'pick and choose among the individual elements of assorted prior art references to recreate the claimed invention,' but rather, we look for 'some teaching or suggestion in the references to support their use in the particular claimed combination'." *Symbol Technologies, Inc. v. Opticon, Inc.,* 935 F.2d 1569, 19 USPQ2d 1241 (Fed. Cir. 1991). The present rejection is unsupported as a matter of law.

For at least these reasons, both independent claims 1 and 2 are patentable over the cited art.

The dependent claims at issue, i.e. 7-9, 22-24 and 26 are also patentable over the cited art since each of these claims contains all of the recitations from their respective independent claim. Furthermore, each of these dependent claims recites additional unique combinations of features for the recited imaging members. The cited art simply fails to provide the requisite teaching to properly support a rejection of any of these claims. Moreover, the Examiner failed to present any reasons for the rejection of

claims 7-8 and 23. It is unknown how the Examiner is attempting to apply the art to these claims.

For at least these reasons, the rejection of claims 1, 2, 7-9, 22-24 and 26 must be withdrawn.

L. Rejection of Claims 4 and 5 Under § 103(a) Must Be Withdrawn

In item 16, on pages 23-24, claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hendrickson combined with Knauf, Grant & Hackh, Borsenberger et al., and Ong '877, and further combined with Horgan.

Claims 4 and 5 both depend from previously discussed claim 1. Claims 4 and 5 recite particular materials for a charge injecting surface. The Examiner adds a patent to Horgan to "fill in" another aspect which is claimed but not taught by the art in conjunction with the other features recited in claim 1. Simply put, Horgan does not remedy the deficiencies of the art collection of Hendrickson, Borsenberger, and Ong, discussed in section K.

For at least these reasons, the rejection of claims 4 and 5 must be withdrawn.

M. Rejection of Claims 1, 2, 6-9, 11-16, 20-24, and 26 Under § 103(a) Must Be Withdrawn

In item 18, on pages 25-29 of the Office Action, the Examiner rejected claims 1, 2, 6-9, 11-16, 20-24, and 26 under 35 U.S.C. § 103(a) as unpatentable over Ong '737 combined with Borsenberger et al., Brown, Hendrickson, Knauf, and Grant & Hackh.

Of the rejected claims, claims 1 and 2 are independent claims.

For this ground of rejection, the Examiner cites a different patent to Ong, the '737 patent, and the same collection of previously cited art along with a new addition, the '220 patent to Brown. The Examiner does not apply the art to Knauf and Grant & Hackh. And so, the present rejection appears to be based upon Ong '737 and Brown, and the previously discussed art to Borsenberger et al. and Hendrickson.

Neither of Ong '737 nor Brown, taken singularly or in combination, remedy the deficiencies of the art to Borsenberger et al. and Hendrickson. That is, the cited art fails to teach an imaging member having the particular combination of features recited in each of independent claims 1 and 2. The Examiner failed to identify any teachings in the cited art of these features.

Furthermore, there is absolutely no suggestion in the art itself to combine the art in the manner attempted by the Examiner.

Since each of the independent claims 1 and 2 is patentable over the cited art, so, too, are claims 6-9, 11-16, 20-24, and 26.

Additionally, the Examiner failed to provide any explanation or theories as to why claims 11, 13, 15, 16, 20, 22, and 23 are unpatentable over the cited art. It is unknown how the Examiner is applying the cited art to these claims.

In view of the foregoing, it is urged that the rejection must be withdrawn.

N. Rejection of Claims 4 and 5 Under § 103(a) Must Be Withdrawn

In item 19 on pages 29-31, claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ong '737 combined with Borsenberger et al., Brown, Hendrickson, Knauf, Grant & Hackh, and further combined with Horgan.

As previously discussed in Section L., claims 4 and 5 depend from claim 1. For this rejection, the Examiner adds another patent to the previously discussed collection of art. The collection, now including seven (7) various patents or books, actually illustrates the weakness and deficiency of the present rejection. That is, in order to recreate the claimed subject matter, the Examiner is forced to resort to no less than seven (7) different items of art.

The newly cited patent to Horgan does not remedy the shortcomings of the collection of art previously discussed in section M. Additionally, the Examiner failed to explain or identify any teaching in the art itself supporting such an intricate combination of selective passages from the various cited patents and books.

For at least these reasons, claims 4 and 5 are patentable over the cited art and the rejection must be withdrawn.

O. Rejection of Claims 1, 2, 6-9, 12-16, 20-24, and 26 Under § 103(a) Must Be Withdrawn

In item 20, on pages 31-34 of the Office Action, the Examiner rejected claims 1, 2, 6-9, 12-16, 20-24, and 26 under 35 U.S.C. § 103(a) as unpatentable over Ong '877 combined with Borsenberger et al., Brown, Hendrickson, Knauf, and Grant & Hackh.

Of the rejected claims, claims 1 and 2 are independent claims. As to the collection of art cited by the Examiner, the Examiner adds the patent to Brown to the same set of art discussed herein under Section K.

The patent to Brown is directed to the incorporation of a barrier layer between photoconductor layers and an outer release layer. In no way does Brown remedy the deficiencies of the art to Borsenberger and Ong '877 (and Hendrickson and Knauf and Grant & Hackh). The Examiner failed to apply or explain the art to Hendrickson, Kanuf and Grant & Hackh, and so, it is not known how that art is being applied in the present rejection.

Furthermore, the Examiner did not explain why or how the cited art renders any of dependent claims 13, 15, 16, 20, 22, 23, 24, and 26 obvious. It is unknown how the Examiner is attempting to apply the cited art to these claims.

In view of the foregoing, the present rejection must be withdrawn.

P. Rejection of Claims 4 and 5 Under § 103(a) Must Be Withdrawn

In item 21, on pages 34-35 of the Office Action, the Examiner rejected claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over Ong '877 combined with Borsenberger et al., Brown, Hendrickson, Knauf, Grant & Hackh, and further combined with Horgan.

For this ground of rejection, the Examiner adds the patent to Brown to the same collection of art discussed in section L. herein. However, Brown does not remedy the deficiencies of the cited collection of art. Nor does the Examiner identify any teaching in the cited art supporting the particular art combination.

This rejection must be withdrawn.

Q. Rejection of Claims 1, 2, 6-9, 12-18, 20-24, and 26 Under § 103(a) Must Be Withdrawn

In item 22, appearing on pages 35-38 of the Office Action, claims 1, 2, 6-9, 12-18, 20-24, and 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over Pai combined with Borsenberger et al., Brown, Hendrickson, Knauf, and Grant & Hackh.

In support of this ground of rejection, the Examiner relied upon the same collection of art as previously discussed in Section M., except instead of Ong '737, the Examiner cited Pai.

Of the rejected claims, the only independent claims are claims 1 and 2. Each of these claims recites, in part, an imaging member that comprises an array of layers in combination with a cross-linked silicone rubber, and a further combination with a resilient, electrically insulating overcoating layer.

Although the Examiner correctly notes that Pai mentions the possible use of an optional overcoat layer (col. 20, lines 54-55), this is not a sufficient teaching to support the present rejection. In fact, Pai continues and describes many different types of overcoats, "[t]hese overcoating..layers..may comprise thermoplastic organic polymers or inorganic polymers that are electrically insulating or slightly semiconductive." Col. 20, lines 58-63.

Furthermore, Pai entirely fails to describe or provide any teaching for the use of a cross-linked silicone rubber in the recited imaging members of claims 1 and 2. Moreover, Pai entirely fails to provide any teaching for that aspect in combination with the other elements recited in each of those claims. Simply put, Pai fails to remedy the shortcomings of the other art cited by the Examiner allegedly supporting the present rejection, i.e. Borsenberger, Brown, Hendrickson, Knauf, and Grant & Hackh.

The Examiner failed to apply any of Hendrickson, Knauf, or Grant & Hackh to any of the claims at issue. Accordingly, it is unclear how the Examiner is combining these three (3) items with the other three (3) items of art, i.e. Pai, Borsenberger, and Brown.

Additionally, the Examiner entirely failed to explain the rejection of claims 13-16, 20, 22-24, and 26. It is unknown how the Examiner is piecing together the six (6) items of art to reject those claims.

For at least these reasons, the Examiner will appreciate that the present rejection must be withdrawn.

R. Rejection of Claims 4 and 5 Under § 103(a) Must Be Withdrawn

In item 23, on pages 38-40 of the Office Action, claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as unpatentable over Pai combined with Borsenberger et al., Brown, Hendrickson, Knauf, Grant & Hackh, and further combined with Horgan.

For this ground of rejection, the Examiner added the patent to Horgan for a total of seven (7) items of art in rejecting claims 4 and 5. The resulting collection of art now parallels the array of art discussed in Section N. herein, except that the Examiner cites Pai instead of Ong '737.

Claims 4 and 5 each depend from claim 1, and so, each contains the recitations from that claim. The newly added patent to Horgan fails to remedy the deficiencies of the art in supporting a rejection of claim 1. And so, it follows that Horgan also fails to remedy the deficiencies of the art in supporting a rejection of claims 4 and 5.

This ground of rejection must be withdrawn.

S. Rejection of Claim 19 Under § 103(a) Must Be Withdrawn

In item 24, on pages 40-41 of the Office Action, claim 19 was rejected under 35 U.S.C. § 103(a) as unpatentable over Pai combined with Borsenberger et al., Brown, Hendrickson, Knauf, and Grant & Hackh, and further combined with Yanus.

Claim 19 depends from claim 15, which as now amended depends from claim 14, which in turn depends from claim 13, which depends from independent claim 1.

The Examiner correctly notes that Yanus discloses sebacoyl chloride in Example III of that patent. However, the Examiner fails to provide any reasons as to a teaching provided by the collection of art for incorporating the combination of features recited in claims 19, 15, 14, 13 and 1. For example, where is a teaching in the art of providing an imaging member having a charge transporting layer that includes a resinous binder comprising polysebacoyl (claim 19) in conjunction with that layer containing particular aryl amines (claims 13, 14 and 15) in combination with that imaging member also comprising a cross-linked silicone rubber, in further combination with the other aspects

recited in claim 1? The Examiner entirely failed in providing any supportable basis for the present rejection.

For at least these reasons, the present rejection must be withdrawn.

T. Rejection of Claims 1, 2, 7-9, 13, 15, 16, 22-26 Under § 102(b), Or in the Alternative, Under § 103(a) Must Be Withdrawn

In item 26, on pages 42-46 of the Office Action, claims 1, 2, 7-9, 13, 15, 16, and 22-26 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Nguyen combined with Hendrickson, Knauf, Grant & Hackh, Springett, and Borsenberger et al.

Although Applicants disagree with the Examiner's speculative interpretation of Nguyen, in order to expedite allowance of the claims at issue, claims 1 and 2 have been clarified to specifically recite a particular arrangement between the hole blocking layer, the charge injecting surface, and the charge transport layer. No new matter is added by these clarifications since support is found throughout the present application, and particularly with Figs. 1 and 2.

Independent claims 1 and 2 now each recite that the hole blocking layer is disposed between the charge injecting surface and the charge transport layer. Referring to Nguyen and considering the Examiner's construction of Nguyen's "charge injection barrier layer" to be the hole blocking layer of the present claims, it is evident from Nguyen that such an arrangement is not disclosed nor taught. Referring to Figs. 6 and 7 of Nguyen, the barrier layer is depicted as disposed on top of the organic photoconductor (OPC) array. The Abstract of Nguyen expressly notes this arrangement.

Clearly, there is no anticipation of any of the claims at issue by Nguyen, particularly in view of the clarifications to claims 1 and 2. As for the Examiner's alternate obviousness rejection, that, too, fails in view of the failure by Nguyen of any teaching as to the subject matter of claims 1 and 2, particularly as now clarified. Furthermore, there is absolutely no teaching of these aspects in combination with the other features recited in claims 1 and 2. In fact, if one followed the teachings of Nguyen, one would be directed away from the subject matter of claims 1 and 2 since Nguyen teaches the placement of the barrier layer on top of the OCP. There is

absolutely no teaching of providing a hole blocking layer (or of a barrier layer as the Examiner argues) between a charge-injecting surface and a charge transport layer.

The Examiner also cited Springett, however that patent fails to remedy the deficiencies of Nguyen.

Furthermore, the Examiner failed to provide any explanation as to how the cited art renders any of claims 7, 22, and 23 obvious. It is unknown how the Examiner is attempting to apply the cited art to these claims.

For at least these reasons, the present rejection must be withdrawn.

U. Rejection of Claims 1, 2, 4-9, 13-16, and 21-26 Under § 103(a) Must Be Withdrawn

In item 27, on pages 46-51, claims 1, 2, 4-9, 13-16, and 21-26 were rejected under 35 U.S.C. § 103(a) as unpatentable over Chu combined with Nguyen, Hendrickson, Knauf, and Grant & Hackh.

In this ground of rejection, the Examiner relied upon the same collection of art as discussed in section T., however replacing the art items to Springett and Borsenberger with a patent to Chu. The '612 patent to Chu represents the state of the art from over twenty-five (25) years ago, and so, is not particularly relevant to the pending claims.

The Examiner admits that Chu fails to describe the use of a cross-linked silicone rubber, as recited in claims 1 and 2. In an attempt to support the rejection, the Examiner points to Nguyen for the mention of a top coat formed from polydimethyl siloxane. Notwithstanding the many differences between Nguyen and the claims at issue, there is no suggestion in the art for the attempted combination. That is, there is no motivation provided in any of the cited art to combine disclosures of patents that are more than twenty-five (25) years apart. Surely, the Examiner appreciates that the field of imaging arts is a rapidly changing one, in which a wide array of developments have occurred.

The Examiner did not provide any reasons for the rejection of claims 8, 9, 13, 22, 23, 24, and 26; and so, it is unknown how the cited art renders any of those claims obvious.

For at least these reasons, all of the claims at issue are patentable over the cited art. The rejection must be withdrawn.

V. Conclusion

Claims 1, 2, 4-26, and 28-29 are believed to be in a condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

No additional fee is believed to be required for this Amendment. However, the undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Deposit Account No. 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Richard M. Klein, at Telephone Number (216) 861-5582.

Respectfully submitted,

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April 27, 2004
Date

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